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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,996	03/13/2001	Hiroyuki Sekihata	1095.1170/JDH	9371

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/803,996

Applicant(s)

SEKIHATA ET AL

Examiner

Steven B. McAllister

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*[Signature]*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
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| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claims 1, 2, and 5-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are unclear due to the unclear use of "collation" and "collated".

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11 lacks any recitation of a technological element performing the method (e.g., a computer).

***Note Regarding Examination***

It is noted that as required by MPEP 2144.03(C), the statements that subject matter is "old and well known in the art" are interpreted as admitted prior art since such statements must be traversed in the subsequent reply.

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***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 8, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al in view of "MIT Report to the President 1994-95" and Saito et al (6,669,832).

Green et al show managing book stock information; managing bibliographic information; and managing loan information. Green et al do not show managing order information, ordering, receiving collation information, or transmitting received collation information to the vendor. MIT Report managing order information and placing an order. It would have been obvious to one of ordinary skill in the art to modify the method and apparatus of Green et al by adding the order information management and order placing means in order to streamline the acquisition process. Saito et al show receiving collation information and transmitting collation information to the vendor. It would have been obvious to one of ordinary skill in the art to further modify the apparatus and method of Green et al by receiving and transmitting collation information in order to track and close out the fulfillment process.

As to claim 4, it is noted that the Green et al in view of MIT Report shows means capable of receiving collation information comprising the central processing unit which is networked to the branches (see, e.g. Fig. 1 of Green et al); and means capable of

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transmitting the collation information to the vendor (see the networked link between the central computer of MIT Report and the vendor).

As to claim 6, the ordering means is capable of placing an order at a price reduced in accordance with an order quantity.

Alternatively, Green in view of MIT Report shows all elements of claim 6 except placing an order at a reduced price based on quantity. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the apparatus by placing an order at a reduced price based on quantity in order to save money.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al in view of MIT Report and Saito et al as applied to claim 1 above, and further in view of Rubin et al (6,078,897).

Green et al in view of MIT Report show all elements of the claim except a reduced price estimating means for estimating a reduced price. Rubin et al show a reduce price estimating means. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Green et al by using the discount estimator of Rubin et al in order more easily facilitate the use of volume discounts.

Claims 1, 2, 5, 6, 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epixtech in view Green et al in view of MIT Report.

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~~Epixtech shows book stock information management means; bibliographic~~

information management means; loan information management means; order information management means capable of managing information on books ordered by individual libraries; and ordering means capable of ordering based on the managed information. Epixtech does not explicitly show collation information receiving means capable of receiving collation information from the individual libraries, collation information transmitting means capable of transmitting the collation information to the vendor; or that the order information management means and ordering means are capable of dealing with ordering information from individual libraries. Green shows means capable of receiving collation information comprising the central processing unit which is networked to the branches (see, e.g. Fig. 1 of Green et al). It would have been obvious to one of ordinary skill in the art to modify the apparatus by providing the means as taught by Green in order to held coordinate the intake of books over a plurality of libraries. MIT shows means capable of transmitting the collation information to the vendor (see the networked link between the central computer of MIT Report and the vendor); and order information management means and ordering means capable of handling orders from individual libraries. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Epixtech by providing the elements of MIT in order to close out the fulfillment process and to ease the process of ordering for several different libraries.

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As to claim 2, epixtech shows that the loan information management means

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enables a library to modify the loan information of another library since it checks books in and out on interlibrary loan and enters their status.

As to claim 5, Epixtech shows a reservation means and a means for registering the books into the stock information means. It is noted that it is inherently possible to register an unreceived book into the database since only data is needed to populate the database. Epixtech does not explicitly show reserving loan of the unreserved book. It is further noted that it is possible to reserve an item in the database.

Alternatively, Epixtech shows a reservation means and a means for registering the books into the stock information means. It is noted that it is inherently possible to register an unreceived book into the database since only data is needed to populate the database. Epixtech does not explicitly show reserving loan of the unreserved book. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the apparatus to allow for reservation before receipt in order to facilitate the timely use of materials and to provide better user service.

As to claim 6, the ordering means is capable of placing an order at a price reduced in accordance with an order quantity.

Alternatively, the combination shows all elements of claim 6 except placing an order at a reduced price based on quantity. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art

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to further modify the apparatus by placing an order at a reduced price based on quantity in order to save money.

As to claim 8, epixtech shows statistical information generating means.

As to claim 9, epixtech shows request receiving means, searching means, and result transmitting means.

As to claim 10, Epixtech shows all elements except SDI keyword registration means and new information sending means. However, it is notoriously old and well known in the art to register a SDI keyword and receive information when a new book corresponding to that keyword is registered. It would have been obvious to one of ordinary skill in the art to do so in order to provide the user with relevant information automatically, saving labor.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



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~~TWO MONTHS of the mailing date of this final action and the advisory action is not~~

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

**STEVE B. MCALLISTER  
PRIMARY EXAMINER**